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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,102	09/09/2003	Kelly A. Dunn	05408/100L619-US1	9954
7278	7590	11/14/2006	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			COTTON, ABIGAIL MANDA	
			ART UNIT	PAPER NUMBER

1617

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/658,102

Applicant(s)

DUNN ET AL.

Examiner

Abigail M. Cotton

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/9/03, 2/12/04 and 2/23/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 (in part), 2-8 and 27-28 (in part), drawn to a method of controlling allergens by applying an anti-allergenic agent having a tertiary amine having the formula $NR^1R^2R^3$ where R^1 is a C_1 - C_{18} alkyl and R^2 and R^3 are $-(CH_2)_3NH_2$, as for example in parts (a) and (b) of claim 1, classified in class 514, subclass 740, for example.
- II. Claims 1 (in part), 9-13 and 27-28 (in part), drawn to a method of controlling allergens by applying an anti-allergenic agent having erythorbic acid or a salt thereof, as for example in parts (c) and (d) of claim 1, classified in class 514, subclasses 473-474, for example.
- III. Claims 1 (in part) and 27-28 (in part), drawn to a method of controlling allergens by applying an anti-allergenic agent having a hydantoin or hydantoin blend, as for example in part (e) of claim 1, classified in class 514, subclass 359, for example.
- IV. Claims 14-19 and 24-26 (in part), drawn to an anti-allergenic formulation or a wipe comprising a tertiary amine having the formula $NR^1R^2R^3$ where R^1 is a C_1 - C_{18} alkyl and R^2 and R^3 are $-(CH_2)_3NH_2$, as for example in parts (a) and (b) of claims 24 and 26, classified in class 514, subclass 740, for example.

- V. Claims 20-23 and 24-26 (in part), drawn to an anti-allergenic formulation or a wipe comprising erythorbic acid or a salt thereof, as for example in parts (c) and (d) of claims 24 and 26, classified in class 514, subclasses 473-474, for example.
- VI. Claims 24-26 (in part), drawn to an anti-allergenic formulation or a wipe comprising a hydantoin or hydantoin blend, as for example in part (e) of claims 24 and 26, classified in class 514, subclass 359, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions IV-VI and I-III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the products can be used in materially different processes, such as preservatives for cosmetic or other products.

Because these inventions are distinct for the reasons given above and the search required for Groups I-III is not required for Groups IV-VI, restriction for examination purposes as indicated is proper. It is noted that while the searches of Groups I-III and IV-VI may be overlapping, there is no reason to believe that the

searches would be co-extensive. In searching Groups IV-VI, the Examiner will be focusing on the patentability of the product itself, and not the process of using of Groups I-III. Conversely, in searching Groups I-III, the Examiner will be focusing on the patentability of the process and not the product itself. Accordingly, a search for both groups would pose an undue burden on the Office.

Inventions IV-VI are directed to related products. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed require different compounds having different classifications in the art, which compounds are recognized by those of ordinary skill in the art as having different chemical reactivities, and thus different modes of operation, function and effect. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Because the inventions IV-VI are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02) due to their classification in different classes and subclasses. Accordingly, restriction for examination purposes as indicated is proper.

Inventions I-III are directed to related processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed require different compounds having different classifications in the art, which compounds are recognized by those of ordinary skill in the art as having different chemical reactivities, and thus different modes of operation, function and effect. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Because the inventions I-III are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02) due to their classification in different classes and subclasses. Accordingly, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Furthermore, should Applicants elect the inventions of Groups I-II or IV-V, Applicants will be required to elect a single species for examination from the following distinct species:

(1) if Applicants elect the claims of Group I or IV (tertiary amine as anti-allergenic agent), Applicants are further required to elect from among the species of co-agents that are sodium carbonate, a natural acid, and a natural base;

(2) if Applicants elect the claims of Group II or V (erythorbic acid as anti-allergenic agent), Applicants are further required to elect from the species of co-agents that are a natural acid and a natural base.

Claims 1-2 and 24-28 are generic to the disclosed patentably distinct species of Groups I and IV (tertiary amine) as listed above. Claims 1, 9 and 24-28 are generic to the disclosed patentably distinct species of Groups II and V (erythorbic acid) as listed above.

The species are independent or distinct because the species are drawn to different compounds, i.e. acids, bases and sodium carbonate, that are recognized as having different chemical properties, functions and effects, and that are not considered to be obvious over one another. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

Due to the complicated nature of the restriction, the restriction requirement is being made via written correspondence in lieu of a telephone interview.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail M. Cotton whose telephone number is (571) 272-8779. The examiner can normally be reached on 9:30-6:00, M-F.

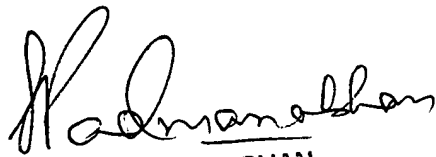
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax

Art Unit: 1617

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMC



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER